

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Matt Sauer et al.

Application No.: 10/568,741

Confirmation No.: 4144

Filed: February 17, 2006

Art Unit: 1638

For: PROMOTERS FOR THE EXPRESSION OF
GENES IN TAGETES

Examiner: Brent T. Page

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed May 4, 2007, Applicants provisionally elect Group IV, claims 19-21, 25-36, 40 and 44, and SEQ ID NO: 11, with traverse. Applicants respectfully traverse and strongly urge reconsideration and withdrawal of the restriction requirement for the following reasons.

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. Unity of invention is fulfilled “when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression “special technical feature” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” (PCT Rule 13.2).

The Examiner argues that the inventions of Group I-VI do not relate to a “special technical feature” which defines a contribution over the prior art, citing Benfey et al. (1990, The Plant Cell 2:849-856). Applicants respectfully disagree that the inventions of the present application do not make a contribution over the reference cited by the Examiner.

As stated in the specification and repeated in the claims, the general inventive concept of the present application relates to methods of using promoters which show flower-specific expression in plants of the genus *Tagetes*. See specification at page 1, lines 5-6. As discussed in the specification, Benfey et al. discloses the EPSPS promoter as a petal-specific promoter for the expression of genes in *Petunia* hybrid, which is not a plant of the genus *Tagetes*. Thus, Benfey et al. does not disclose a method of using EPSPS promoter as a flower-specific promoter for expression in plants of the genus *Tagetes*. Because Benfey et al. does not establish the general inventive concept or the special technical feature of the present invention, Applicants respectfully request that the restriction requirement be reconsidered and all the claims be examined in one application.

The Examiner has further required an election of a single nucleotide sequence, the particular sequence being dependent on the Group elected. Applicants disagree with this requirement and request reconsideration and withdrawal. The sequences are related to each other by sharing a common feature of specificity as being highly suitable for the flower-specific expression, particularly petal-specific expression, of genes in plants of the genus *Tagetes*. See, e.g., Specification at page 1, lines 30-39. Furthermore, as described in the specification at page 6 (lines 19-27), 10 (lines 28-37), 13 (lines 26-36) and 16 (lines 28-38), some of the promoter sequences in the specification and recited in claim 1 are related to other sequences. For example, SEQ ID NOs: 11-14 represent promoter sequences of the chromoplast-associated protein C (CHRC) from cucumber. See Specification at page 16, lines 28-38. For these reasons, Applicants respectfully request that the requirement for restriction to one sequence be reconsidered and removed entirely. In the alternative, Applicants respectfully request that at least provisionally elected SEQ ID NO: 11 be examined together with its highly related variants from the same organism, *Cucumis sativus* (cucumber), SEQ ID NOs: 12-14.

Additionally, Applicants believe that there is no undue burden on the Examiner to search and examine all Groups together. As stated in § 803 of the M.P.E.P. “[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” (M.P.E.P. § 803, emphasis added). Accordingly, Applicants respectfully submit that the restriction requirement should be withdrawn even under restriction practice.

Conclusion

For at least the above reasons, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn. Alternatively, Applicants respectfully request that at least SEQ ID NOs: 11-14 be examined together.

Applicants reserve all rights to pursue the non-elected species in one or more divisional application, if necessary.

Accompanying this response is a petition for a one-month extension of time to and including July 4, 2007 to respond to the Office Action mailed May 4, 2007 with the required fee authorization. No further fee is believed due. However, if any additional fee is due, the Director is hereby authorized to charge our Deposit Account No. 03-2775, under Order No. 13173-00026-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 

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